



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/976,259	10/12/2001	Tsutomu Kurokawa	M1953-41	9702

7278 7590 02/17/2005

DARBY & DARBY P.C.
P. O. BOX 5257
NEW YORK, NY 10150-5257

EXAMINER

BORISSOV, IGOR N

ART UNIT	PAPER NUMBER
----------	--------------

3629

DATE MAILED: 02/17/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/976,259

Applicant(s)

KUROKAWA ET AL.

Examiner

Igor Borissov

Art Unit

3629

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 03 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 December 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 12/14/2004 has been entered.

Response to Amendment

Amendment received on 12/14/2005 is acknowledged and entered. Claim 12 has been amended. Claims 1-19 are currently pending in the application.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-4, 6-11, 14-16 and 18-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Thompson et al. (US 5,973,481) (Thompson) in view of Budike, Jr. (US 6,311,105) (Budike).

Thompson teaches a method and system for distributed electrical power generating stations, comprising:

As per claims 1 and 14,

Art Unit: 3629

at least one generator unit, operated by an electricity provider, supplying electricity to at least one specific electricity consumer in a remote area (column 2, lines 28-33);

a management center (monitoring means) for monitoring information related to generation of energy, said information including an operation status of said at least one generator unit and monitoring an amount of electricity supplied to said at least one specific electricity consumer by said at least one generator unit (column 2, lines 28-42);

a system for communicating information between said management center and said electricity provider (column 2, lines 29-60);

said management center uses wireless communication means to collect information from said at least one generator unit regarding operation status of said at least one generator unit and regarding an amount of electricity supplied to said at least one specific electricity consumer (column 2, lines 29-60);

Thompson does not specifically teach that said wireless communication means includes the Internet; and that said information related to generation of energy, includes billing and payment data for electricity supplied to said at least one specific electricity consumer.

Budike teaches a multi-utility energy control system and method, including back-up generators, wherein a controlled wireless network is provided, said controlled wireless network including the Internet, said Internet wireless communication means is utilized for transmitting billing and payment data for electricity supplied (purchasing electricity in a real time environment) (column 7, lines 53-58).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Thompson to include that said wireless communication means includes the Internet, as disclosed in Budike, because use of the large existing network structure would advantageously allow to conduct said monitoring from any remote geographic location (having an access to the Internet) without incurring expenses for building a dedicated network.

And it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Thompson to include that said information

Art Unit: 3629.

communicated over said wireless communication means and related to generation of energy, includes billing and payment data for electricity supplied, because a business needs funds to operate.

As per claims 2-3 and 6, Thompson teaches at least one local generator unit, operated by an electricity provider, supplying electricity to at least one specific electricity consumer in a remote area (column 2, lines 28-60).

As per claims 4 and 7, Thompson teaches system, further comprising:
a maintenance personnel maintaining and managing operation of said at least one generator unit, wherein said maintenance personnel receives instructions from said management center (column 3, lines 21-25).

As per claims 8, 9, 10 and 11, Budike teaches a multi-utility energy control system and method, including back-up generators, wherein a controlled wireless network, including the Internet, is utilized for for exchange information in a real time environment (column 7, lines 24-59). The motivation to combine Thompson and Budike to include wireless communication means would be to provide a convenient and reliable way of communication over different geographical areas.

As per claims 15 and 16, Thompson teaches a management center, monitoring an operation status of said at least one generator unit and monitoring an amount of electricity supplied to said at least one specific electricity consumer by said at least one generator unit (column 2, lines 28-60).

As per claims 18 and 19, Budike teaches a multi-utility energy control system and method, including back-up generators, wherein a controlled wireless network, including the Internet, is utilized for for exchange information in a real time environment (column 7, lines 24-59). The motivation to combine Thompson and Budike to include wireless communication means would be to provide a convenient and reliable way of communication over different geographical areas.

Claims 5, 12-13 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Thompson in view of Budike in view of Fleckner et al. (US 6,589,682) (Fleckner).

As per claim 12, Thompson and Budike teach all the limitations of claim 12, including that said at least one generator unit is powered by alternative fuels (Budike; column 7, lines 38-40), except that said at least one generator unit is fuel cell generator, and said service company includes a fuel supply company, and said maintenance/management company performing maintenance on said fuel cell generator and responding to irregularities in said fuel cell generator. Also, Thompson and Budike do not specifically teach billing a consumer maintenance and operating service fee.

Fleckner teaches system for fuel cells arrangement, including a monitoring instrumentation 22 (Fig. 1) mounted adjacent to fuel cells for providing information to monitoring system 24 which conveys the data related to the functional status of the fuel cells, fuel level, etc., over a wireless communication network, including the Internet, to the interested party (column 5, lines 10-24).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Thompson and Budike to include that said maintenance/management company performing maintenance on said fuel cell electricity generating device and responding to irregularities in said fuel cell electricity generating device, as disclosed in Fleckner, because, in order to maintain a fuel cell generator, disposed in a remote area, in a proper working order, one must maintain functional status of the fuel cells including a fuel level. And it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Thompson, Budike and Fleckner to include billing a consumer maintenance and operating service fee, because a business needs funds to operate.

Furthermore, language as to: "said management center *billing each of said at least one specific electricity consumer a maintenance and operating service fee*" is directed to method steps. So as claimed invention is directed to *a system*, said language is given no patentable weight.

MPEP 2106 (II) (C) states: "Language that suggests or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation." Therefore, while addressing the

structural limitations of the claim, the Examiner did not give said language patentable weight.

As per claims 5 and 17,

Fleckner teaches said system for fuel cells arrangement, including a monitoring instrumentation 22 (Fig. 1) mounted adjacent to fuel cells for providing information to monitoring system 24 which conveys the data related to the functional status of the fuel cells, fuel level, etc., over a wireless communication network, including the Internet, to the interested party (column 5, lines 10-24). The motivation to combine Thompson and Budike with Fleckner to include maintenance/management company performing maintenance on said fuel cell electricity generating device would be to maintain a fuel cell generator disposed in a remote area in a proper working order.

As per claim 13, Fleckner teaches said system wherein said generator is fuel cells arrangement (column 5, lines 10-24). The motivation to combine Thompson and Budike with Fleckner to include the fuel cells generator would be to enhance the reliability of the generating system by diversifying generating means.

Response to Arguments

Applicant's arguments filed on 12/14/2005 have been fully considered but they are not persuasive.

Applicant argues that there is no suggestion to combine Thompson and Budike, because Thompson teaches a generator having sufficient amount of fuel stored to provide a prolonged operation of said generator, while Budike teaches a system in which a consumer can monitor multiple sources of energy to choose a feasible source.

In response to the applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in

Art Unit: 3629

the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

In this case, both Thompson and Budike teach energy control and distribution method and system, wherein energy is distributed over extended geographical area. Thompson discloses use of a wireless communication means for monitoring information related to energy generation (column 2, lines 27-42). Budike was applied to show that said wireless communication means can include the Internet, and that said wireless Internet communication means can be utilized for transmitting energy related information including billing and payment data for electricity supplied (column 7, lines 53-58).

The motivation to combine the references to include use of the Internet would be advantageously employ the larges existing network structure to implement said monitoring from any remote geographic location (having an access to the Internet) without incurring expenses for building a dedicated network. And the motivation to combine the references to include the use of said wireless communication means for transmitting billing and payment information for electricity supplied, because a business need funds to operate.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure (see form PTO-892).

Any inquiry concerning this communication should be directed to Igor Borissov at telephone number (703) 305-4649 before April 13, 2005, and (571)272-6801 after that date.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Receptionist whose telephone number is (703) 308-1113.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's Supervisor, John Weiss, can be reached at (703) 308- 2702.

Art Unit: 3629

Any response to this action should be mailed to:

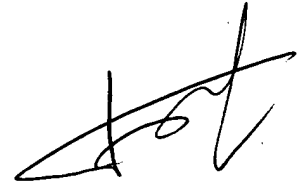
***Commissioner of Patents and Trademarks
Washington D.C. 20231***

or faxed to:

(703) 305-7687 [Official communications; including After Final
communications labeled "Box AF"]

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal
Drive, Arlington, VA, 7th floor receptionist.

Igor N. Borissov
Patent Examiner
Art Unit 3629



IB

2/16/2005